

REMARKS

1. Status of Claims

Claims 1 – 15, 18 – 20, 23, and 24 are currently pending in the application. All of these claims stand rejected pursuant to a Final Office Action mailed August 12, 2005 (hereinafter “the Office Action”).

The rejections of each of the pending claims are believed to be improper.

2. Summary of Claimed Subject Matter

Embodiments of the invention relate to methods for distributing programming. These embodiments find utility in providing an alternative to conventional methods for distributing programming. In particular, methods for delivering programming in the prior art have been dominated by providing programs according to a fixed linear schedule and publishing the schedule in a programming guide (Application, p. 1, ll. 27 – 28). Certain programming viewed as more valuable may be accessed upon payment of a fee according to a “pay-per-view” (“PPV”) model, but the programming is still provided according to a fixed linear schedule (*id.*, p. 1, ll. 30 – 31). Efforts have accordingly been made to provide “on demand” forms of delivering programming. Pure “video on demand” (“VOD”) provides the ability to view a program at any time with control of the playback by the user (*id.*, p. 1, ll. 31 – 32), but suffers from difficulties of having large numbers of programs available. A hybrid approach called “near video on demand” attempts to mimic VOD by making a program available on a number of channels in a linear program with staggered start times, but the user cannot control playback (*id.*, p. 1, l. 32 – p. 2, l. 2).

Embodiments of the invention provide a different paradigm for distributing programming based on subscription access to VOD. In these embodiments, a content provider

allows users to view a predetermined linear schedule of programming on their televisions (*id.*, p. 5, ll. 1 – 3). The linear schedule of programming provided to the user can be watched in real time as the program is broadcast (*id.*, p. 5, ll. 2 – 4). A subset of the users who subscribe to the additional content may also subscribe to an additional level of benefits, referred to in the application as the “club” (*id.*, p. 5, ll. 4 – 5). The club members can access a subset of or all of the linearly scheduled content, but can do so with playback control by executing such commands as “rewind,” “fast-forward,” “pause,” and the like (*id.*, p. 5, ll. 5 – 8).

a. Independent Claim 1

Independent Claim 1 recites a method for distributing programming that encompasses this paradigm. A first set of programs is transmitted in real time according to a schedule of programming (*id.*, p. 12, ll. 16 – 17). A second set of programs is stored on a server located on a set-top box local to the user (*id.*, p. 17, l. 33 – p. 18, l. 2). At least one of the first set of programs has a counterpart in the second set of programs that is substantially identical to the one of the first set of programs (*id.*, p. 10, ll. 28 – 33). As explained in the Amendment filed February 17, 2005, this language “is intended to require that at least one of the first set of programs that is transmitted in real time have a substantially identical copy that is stored on a server located on a set-top box local to the user.” The second set of programs corresponds to the “club” programs and at least one of these programs is played from the server under the control of the user (*id.*, p. 13, ll. 23 – 26).

b. Independent Claim 18

Several of the limitations of independent Claim 18 are the same as those of Claim 1, including transmitting the first set of programs in real time according to a programming schedule and storing the second set of programs on a server located on a set-top box local to the

user. At least one of the first set of programs has a counterpart in the second set of programs that is substantially identical to the at least one of the first set of programs.

Claim 18 additionally requires that a request be detected from the user for program control over one of the programs in the first set of programs, i.e. over one of the programs being transmitted in real time according to a programming schedule (*id.*, p. 16, ll. 6 – 16). If so, a determination is made whether that program has a counterpart program stored on the server (*id.*, p. 16, ll. 18 – 19). If the determination is positive, so that the counterpart program is one of the second set of programs stored on the server, the counterpart program is played from the server under the control of the user (*id.*, p. 16, l. 29 – p. 17, l. 6). In this way, the user is provided with program-control access to a club program.

c. Independent Claim 23

Several of the limitations of independent Claim 23 are also the same as those of Claim 1, including transmitting the first set of programs in real time according to a schedule of programming and storing the second set of programs on a server located on a set-top box local to the user. At least one of the first set of programs has a counterpart in the second set of programs that is substantially identical to the at least one of the first set of programs.

Claim 23 additionally requires receiving a program-control signal from the user (*id.*, p. 16, ll. 6 – 16). A temporal position for the transmission of a particular program according to the schedule of programming is ascertained when the program-control signal is received (*id.*, p. 16, ll. 29 – 31). A switch is made from transmission of the particular program according to the schedule of programming to transmission of the program from the server at substantially the same temporal position (*id.*, p. 16, l. 31 – p. 17, l. 1). In this way, a club program may be substituted for the scheduled program in a manner transparent to the user (*see id.*, p. 17, ll. 1 – 3).

3. Grounds of Rejection

a. Whether Claims 1 – 8, 11, 13, 14, 18, 19, 23, and 24 are unpatentable under 35 U.S.C. §103(a) over U.S. Pat. No. 5,530,754 (“Garfinkle”) in view of U.S. Pat. No. 6,532,589 (“Proehl”) and U.S. Pat. No. 6,510,554 (“Gordon”).

b. Whether Claims 9, 10, 12, 15, and 20 are unpatentable under 35 U.S.C. §103(a) over Garfinkle, Proehl, and Baker,¹ further in view of U.S. Pat. No. 5,604,528 (“Edwards”).

4. Argument

a. Whether Claims 1 – 8, 11, 13, 14, 18, 19, 23, and 24 are unpatentable over Garfinkle in view Proehl and Gordon

For a rejection to be maintained under 35 U.S.C. §103(a), the Examiner is charged with factually supporting a *prima facie* case of obviousness. MPEP 2142. Such a *prima facie* case requires, *inter alia*, that all limitations of the claims be taught or suggested by the cited references and that there be a motivation to combine them as proposed. In this instance, certain limitations are not disclosed by the cited art and there is no motivation to modify their teachings as the Office Action proposes.

The Office Action relies on Garfinkle as the primary reference. This reference is directed to a conventional video-on-demand system (*see* Garfinkle, abstract). As is well known in the art, the advantage of a VOD system is that it is not constrained by a fixed programming schedule, permitting users to access programs whenever they desire. But the Office Action proposes to modify this fundamental aspect of Garfinkle by combining it with Proehl, which is directed generally to an electronic program guide (*see* Proehl, abstract) to provide the first set of programs according to a schedule of programming (*see* Office Action, pp. 5 – 6). But there is clearly no motivation to modify Garfinkle in this way since it reduces flexibility that is otherwise

available. Specifically, the Office Action refers to “the desirable advantage of providing the subscriber with the option of accessing one or more programs at specific predetermined times, i.e. when they are broadcast” (*id.*, p. 6). But Garfinkle already permits subscribers to access programs “on demand,” i.e. at *any* time, so there is no “desirable advantage” of a restriction to “specific predetermined times.”

In this respect, the Office Action’s citation of Col. 6, ll. 61 – 67 of Proehl as providing a basis for motivating the modification is misplaced. This portion of Proehl refers to combining its electronic programming guide with conventional VCR functionality, permitting programs to be recorded and viewed later. As such, it teaches a way of avoiding the constraints imposed by programming schedule — it clearly does not suggest the imposition of such constraints on a system that is already flexible in allowing users to view programming “on demand.”

The Office Action relies on this combination of Garfinkle with Proehl in the rejections of all independent claims, i.e. Claims 1, 18, and 23. Since there is no motivation to make the combination in the manner asserted, the rejection is respectfully believed to be improper.

In addition, the Office Action notes Garfinkle’s disclosure of providing lead-ins or trailers that are stored as part of catalog data at user sites (Office Action, p. 6). The Office Action would like to identify the lead-ins or trailers as the “second set of programs” and the programs that are transmitted as video-on-demand programs as the “first set of programs.” But none of the lead-ins or trailers is “substantially identical to ... one of the first set of programs [i.e. the video-on demand programs]” as required by the claims (*see* Garfinkle, Col. 4, ll. 19 – 22 explaining that the “lead-in is an initial segment of the video product” (emphasis added) of about two minutes). It appears that the Office Action relies on the mere commonality of a portion of one of the first set of programs with the lead-in to assert that the limitation is disclosed.

¹ The current Office Action does not identify “Baker,” but it presumably refers to U.S. Pat. No. 5,582,561, cited in a previous Office Action.

But such a position is untenable. It relies on a construction of the term “program” that is inconsistent with its normal and customary usage. The Office Action has provided no evidence that Applicants intended the term to be construed other than in accord with its normal and customary usage, and indeed confirm their intent to have it so construed. The claim language requires substantial identity between the counterpart in the second set of programs and the at least one of the first set of programs. It is noted that such a requirement results in the advantage that a switch may be made from the real-time transmission to the counterpart program at any time during the transmission of the real-time program. With the construction proposed by the Office Action, such a switch could only be made during the first two minutes of a (say) 120-minute program, thereby defeating one of the advantages of the invention.²

Deficiencies with the rejection of independent Claim 18 is also noted. In particular, Claim 18 includes a limitation requiring “detecting a request from the user for program control over one of the programs in the first set of programs” and “determining whether the requested program has a counterpart stored on the server.” Neither of these limitations is recited in any of Claims 1 – 15, but the Office Action asserts only that “[c]onsidering claim 18, the method steps that correspond with subject matter above in the rejection of claim 1, are likewise treated” (Office Action, p. 9). The Office Action has not cited any prior art where the “detecting” and “determining” steps are disclosed and it is respectfully believed that they are not disclosed in the cited art. Claim 18 is accordingly believed to be patentable.

For the foregoing reasons, each of independent Claims 1, 18, and 23 is believed to be patentable, and the claims that depend therefrom are believed also to be patentable by virtue of their dependence from patentable claims.

b. Whether Claims 9, 10, 12, 15, and 20 are unpatentable over Garfinkle, Proehl, and Baker, further in view of Edwards

² It is believed that the arguments presented in the main text are sufficient to establish patentability of the claims. It is noted, however, that the Office Action inconsistently refers to “Gordon” in summarizing the rejection (Office Action, p. 5) but then makes repeated reference to disclosures from “Baker” in the more detailed comments. Clarification is requested.

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Claims 9, 10, 12, 15, and 20 are dependent from either Claim 1 or Claim 18, and are believed to be patentable by virtue of their dependence from a patentable claim.

5. Double Patenting

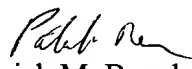
The provisional double patenting rejection is noted. Applicants will consider submission of a terminal disclaimer should the provisional rejection mature into a rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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